

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

Summary of the Office Action

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Wiley* (U.S. Patent No. 4,854,038).

The Examiner is thanked for indicating that claims 5-15 are allowed and claims 2 and 4 contain allowable subject matter.

Summary of the Response to the Office Action

Applicants have amended independent claim 1 to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Also, Applicants have rewritten each of allowable claims 2 and 4 in independent form. Accordingly, claims 1-15 remain pending with claims 5-15 being allowed.

All Claims Define Allowable Subject Matter

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Wiley*. To the extent that this rejection might be reapplied to the claim as presently amended, it is respectfully traversed as being based on a reference that neither teaches nor suggests the novel combination of features recited in the claims.

With respect to independent claim 1, as newly-amended, Applicants respectfully submit that *Wiley* does not teach or suggest a claimed combination including at least a feature that “forming an optical waveguide in the vicinity of the via holes to form the opto-via holes.”

In contrast to the present invention of newly-amended independent claim 1, *Wiley* fails to teach or suggest a step of forming an optical waveguide in the vicinity of the vias 13. In other words, *Wiley* fails to teach or suggest the claimed combination including at least a feature that “forming an optical waveguide in the vicinity of the via holes to form the opto-via holes,” as recited by newly-amended independent claim 1.

Accordingly, for at least the forgoing reasons, Applicants respectfully assert that the rejection of independent claim 1 under 35 U.S.C. § 102(b) should be withdrawn because the applied reference does not teach or suggest each and every feature of independent claim 1, as newly-amended. As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Furthermore, the objection to claims 2 and 4 should be withdrawn because Applicants have rewritten claims 2 and 4 in independent form including all of the limitations of the base claim. Also, claim 3 is allowable at least because of its dependency from independent claim 1 and the reasons set forth above.

With no other rejections pending, Applicant respectfully asserts that claims 1-15 are in condition for allowance.

Conclusion

In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: July 25, 2005

By: 

Robert J. Goodell
Registration No. 41,040

Customer No.: 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: 202.739.3000
Facsimile: 202.739.3001